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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/505,621	02/16/2000	Mark A. Hollar	M-7348 US	6010

25226 7590 03/14/2006

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EXAMINER

DAVIS, ZACHARY A

ART UNIT PAPER NUMBER

2137

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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EXAMINER

Davis, Zachary A

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20060308

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Commissioner for Patents

### NOTICE OF NON-RESPONSIVE AMENDMENT

1. The amendment filed on 04 January 2006 canceling all claims drawn to the elected invention and presenting only claims drawn to a non-elected invention is non-responsive (MPEP § 821.03). The remaining claims are not readable on the elected invention for the reasons detailed hereinbelow.

Since the above-mentioned amendment appears to be a *bona fide* attempt to reply, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS, whichever is longer, from the mailing date of this notice within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD UNDER 37 CFR 1.136(a) ARE AVAILABLE.

2. In the analysis below, reference is made to the following inventions, which also correspond to the inventions as described in the restriction requirement mailed 14 January 2004:

I. Canceled Claims 1 and 5, drawn to methods and apparatus for creating data by embedding a watermark and associated data in a video signal, classified in class 713, subclass 176.

III. New Claims 47 and 48, previously withdrawn Claims 12-14, and previously examined Claims 2-4, 6, and 41-46, directed to a set top box including a conditional access control and methods for using that set top box, classified in class 725, subclass 25.

3. Newly submitted claims 47 and 48 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination I has separate utility such as providing a copy controlled signal to a system other than the set top box of invention III. See MPEP § 806.05(d). The Examiner agrees with Applicant's assertion that Claims 47 and 48 recite similar subject matter and should be examined together (page 15 of the present response); however, the Examiner notes that Claims 47 and 48 appear to be directed to the same invention as withdrawn Claim 11, and not the same invention of canceled Claims 1 and 5. The Examiner further notes that Applicant argues that new Claim 48 recites subject matter of canceled Claim 5 (page 15 of the present response). However, the Examiner respectfully disagrees, noting that the structures recited in new Claim 48 are entirely different from the structures recited in canceled Claim 5 (and instead correspond substantially to the structures recited in withdrawn Claim 11); similarly, the method steps recited in new Claim 47 are entirely different from the steps recited in canceled Claim 1.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Art Unit: 2137

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 2-4, 6, 12-14, and 41-48 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachary A. Davis whose telephone number is (571) 272-3870. The examiner can normally be reached on weekdays 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ZAD  
zad

  
EMMANUEL L. MOISE  
SUPERVISORY PATENT EXAMINER